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EXAMINER

TOLENTINO, RODERICK

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,354

Applicant(s)

KIM ET AL.

Examiner

Roderick Tolentino

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/08/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 27 are pending.

Response to Arguments

2. Applicant's arguments regarding all 102 and 103 rejections, with respect to claims 1 - 27 have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments regarding all 101 rejections, filed 11/08/2005 have been fully considered but they are not persuasive.
4. Applicant's amendments made to claim 1, still have no affect on the argument made by examiner that the claimed invention is non-statutory subject matter based on the fact that the claimed invention is "nonfunctional descriptive material." The definition for "nonfunctional descriptive material" includes but is not limited to music, literary works and compilation or mere arrangement of data (MPEP 2106, Section IV). When nonfunctional descriptive material is recorded on a computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. The amended claim by applicant shows intended use, of identifying the copyright owner of the original piece of data and the maker of the remake content, but lacks the functional correlation with a computer system, necessary to overcome the 101 rejection. Thus, leaving the claim to still be "nonfunctional descriptive material," on a computer readable medium. (MPEP 2106)

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See MPEP 2106:

7. As per claim 1, the claimed invention is non-statutory subject matter since non-functional descriptive material is recorded on some readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[Each invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.]") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under copyright law.

8. As to claims 2-7 all are rejected due to their dependency on the rejected claims and they fail to avoid the basis for which those claims are held non-statutory unpatentable.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 6, 8, 9, 11 – 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz et al. U.S. Patent No. (5,926,624).

11. As per claim 1, Katz teaches a remake content made based on at least one original content (Katz, Col. 6 Lines 47 – 50, selected preview clips) and copyright information corresponding to the remake content, the copyright information including original copyright information to identify at least a copyright owner of the original content and remake copyright information to identify at least a maker of the remake content (Katz, Col. 6 Lines 55 – 61).

12. As per claim 6, Katz teaches the remake content is recorded in at least one audio packet containing audio data and the original copyright information and the remake copyright information are recorded in a private header containing header information on the remake content (Katz, Col. 6 Line 55 – 61, Col. 9 Lines 1 - 6).

13. As per claim 8, Katz teaches, making a remake content based on at least one original content (Katz, Col. 6 Lines 47 – 50, Selected preview clips), recording the remake content on the recording medium (Katz, Col. 8 Lines 32 – 42, transfers to client computer) and generating and recording copyright information corresponding to the remake content on the recording medium, the copyright information including original copyright information to identify at least a copyright owner of the original content and remake copyright information to identify at least a maker of the remake content on the recording medium (Katz, Col. 6 Lines 55 – 61).

14. As per claim 9, Katz teaches the making of a remake content, the remake content is made by sampling the original content (Katz, Fig. 3 Items 307, 310 and 323, Raw Data and Preview Generator).

15. As per claim 10, Katz teaches the making of a remake content, the remake content is made by a different coding method from a coding method by which the original content is made (Katz, Fig. 3 Item 318, Col. 7 Lines 49 – 50, scrambler, Col. 5 Lines 60 – 64, Raw Data no coding).

16. As per claim 11 Katz teaches during the making of a remake content, the remake content is made by reading the original content from another recording medium and recording the original content in the recording medium different from the another recording medium (Katz, Fig. 3 Item 307, Raw data and Fig. 323, Preview Generator).

17. As per claim 12, Katz teaches the original content includes audio data or video data (Katz, Col. 5 Lines 46 – 65).

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18. As per claim 13, Katz teaches the recording of the remake content, the remake content is recorded as at least one audio packet containing the remake content, and during the recording of original copyright information to identify at least a copyright owner of the original content and remake copyright information to identify at least a maker of the remake content, original copyright information and remake copyright information are recorded in a private header for at least one audio packet in which the remake content is recorded (Katz, Col. 6 Line 55 – 61, Col. 9 Lines 1 - 6).

19. As per claim 15, Katz teaches a converting unit to convert at least one original content into a remake content (Katz, Fig. 3 Item 323), a processor to generate copyright information including original copyright information on the original content and remake copyright information (Katz, Col. 6 Lines 23 – 30 and Lines 55 – 61), and a recording unit to record the remake content obtained by the converting unit, the identification information and the copyright information generated by the processor on a recording medium (Katz, Col. 8 Lines 32 – 42, transfers to client computer).

20. As per claim 16, Katz teaches a decoder to decode the original content (Katz, Col. 6 Line 67 and Col. 7 Lines 1 – 3, descrambler) and an encoder to encode the original content decoded by the decoder into a remake content (Katz, Fig. 3 Item 318, Col. 7 Lines 49 – 50).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. U.S. Patent No. (5,926,624) in view of Fuchigami et al U.S. Patent No. (5,960,398).

23. As per claims 2, 14 and 19 Katz teaches copyright information that includes an identification code of the apparatus used to identify the maker of the remake content (Katz, Col. 6 Lines 55 – 61, medium from which digital information originated), but fails to teach copyright information that includes a producer code of an apparatus used in making the remake content. However, Fuchigami teaches copyright information that includes a producer code of an apparatus used in making the remake content (Fuchigami, Col. 5 Lines 46 – 56, SID).

24. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Fuchigami's copyright embedding apparatus with Katz's Digital information delivery service because it offers the advantage of managing copyrights in a storage medium (Fuchigami, Col.1 Lines 5 – 11).

25. As per claim 3, Katz as modified teaches the remake copyright information further includes encoding information by which a reproducing apparatus can determine whether reproducing the remake content is possible (Katz, Col. 6 Line 67 and Col. 7 Lines 1 – 3, descrambling map, and Col. 6 Lines 55 – 61, copyright).

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26. As per claim 4, Katz as modified teaches the remake copyright information further includes the version of the remake copyright information (Katz, Col. 6 Lines 54 64, Volume).

27. As per claim 5, Katz as modified teaches copyright information that includes the amount of allowable copies are to be made (Fuchigami, et al., Col 5 Line 54, allowable copies).

28. As per claim 7, Katz as modified teaches the original copyright information includes a country code, an owner code, a year of recording and a serial number (Fuchigami, Col. 5 Lines 46 – 56, ISRC).

29. As per claim 20, Katz as modified teaches the remake copyright information further includes information on the number of times that the remakes on the original is permitted (Fuchigami, et al., Col 5 Line 54, allowable copies).

30. As per claim 21, Katz teaches the original content includes audio data or video data (Katz, Col. 5 Lines 46 – 65), but fails to teach the original copyright information is an International Standard Recording Code (ISRC). However, Fuchigami teaches the original copyright information is an International Standard Recording Code (ISRC) (Fuchigami, Col. 5 Lines 46 – 56).

31. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Fuchigami's copyright embedding apparatus with Katz's Digital information delivery service because it offers the advantage of managing copyrights in a storage medium (Fuchigami, Col.1 Lines 5 – 11).

32. As per claim 22, Katz fails to disclose the recording includes decrementing the number of remakes and recording the decremented number as copyright remake content. However Fuchigami discloses the recording includes decrementing the number of remakes and recording the decremented number as copyright remake content (Fuchigami, Col. 5 Line 52-54, allowable copies).

33. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Fuchigami's copyright embedding apparatus with Katz's Digital information delivery service because it offers the advantage of managing copyrights in a storage medium (Fuchigami, Col.1 Lines 5 – 11).

34. As per claim 26, Katz teaches the remake copyright information on the remake content, an identification code of the apparatus used in making the remake content (Katz, Col. 6 Lines 55 – 61, original medium information), encoding information of the remake content (Katz, Col. 6 Line 67 and Col. 7 Lines 1 – 3, descrambler) and the version of the remake copyright information (Katz, Col. 6 Lines 55 – 61, volume), but fails to teach a producer code of an apparatus used in making the remake content. However, Fuchigami teaches a producer code of an apparatus used in making the remake content (Fuchigami, Col. 5 Lines 46 – 56, SID).

35. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Fuchigami's copyright embedding apparatus with Katz's Digital information delivery service because it offers the advantage of managing copyrights in a storage medium (Fuchigami, Col.1 Lines 5 – 11).

36. Claims 17, 18, 24, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. U.S. Patent No. (5,926,624) in view of Bersson U.S. Patent No. (6,081,897).

37. As per claim 17, Katz fails to teach a reading unit to read the original content and the original copyright information from the recording method, wherein the processor generates identification information of the original content by receiving the original copyright information from the reading unit and outputting the original copyright information. However, Bersson teaches a reading unit to read the original content and the original copyright information from the recording method, wherein the processor generates identification information of the original content by receiving the original copyright information from the reading unit and outputting the original copyright information (Bersson, Col. 2 Lines 51 – 65).

38. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Bersson's apparatus for preventing unauthorized copying of digital data with Katz's Digital information delivery service because it offers the advantage of controlling the unauthorized copying of copyrighted work (Bersson, Col. 1 Lines 42 – 44).

39. As per claim 18, Katz as modified teaches the recording unit records the original copyright information and the remake copyright information in a header in which header information on the remake content is recorded (Katz, Col. 6 Lines 54 – 61).

40. As per claim 24, Katz teaches original copyright information to identify at least as copyright owner of the original content and remake copyright information to identify at

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least a maker of the remake content (Katz, Col. 6 Lines 55 – 61), and a reproducing unit to receive and reproduce the remake content read from said reading unit (Katz, Fig. 3 Item 323), but fails to teach a reading unit to read copyright information on a remake content from said recording medium and a processor to determine whether the remake content of the recording medium is reproducible based on the copyright information read from said reading unit and the remake content is reproducible, to issue a command to said reading unit to read the remake content. However, Bersson teaches a reading unit to read copyright information on a remake content from said recording medium and a processor to determine whether the remake content of the recording medium is reproducible based on the copyright information read from said reading unit and the remake content is reproducible, to issue a command to said reading unit to read the remake content (Bersson, Col. 2 Lines 51 – 65).

41. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Bersson's apparatus for preventing unauthorized copying of digital data with Katz's Digital information delivery service because it offers the advantage of controlling the unauthorized copying of copyrighted work (Bersson, Col. 1 Lines 42 – 44).

42. As per claim 25, Katz as modified teaches the reproducing unit further comprises a decoding unit to decode the remake content received (Katz, Col. 6 Line 67 and Col. 7 Lines 1 – 3, descrambler)

43. As per claim 27, Katz teaches original copyright information to identify at least as copyright owner of the original content and remake copyright information to identify at

least a maker of the remake content (Katz, Col. 6 Lines 55 – 61) and reproducing the remake content (Katz, Fig. 3 Item 323), but fails to teach reading copyright information from a recording medium, determining whether a remake content is reproducible from the recording medium based on the copyright information and reading the remake content from the recording medium based on the copyright information. However, Bersson teaches reading copyright information from a recording medium, determining whether remake content is reproducible from the recording medium based on the copyright information and reading the remake content from the recording medium based on the copyright information (Bersson, Col. 2 Lines 51 – 65).

44. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Bersson's apparatus for preventing unauthorized copying of digital data with Katz's Digital information delivery service because it offers the advantage of controlling the unauthorized copying of copyrighted work (Bersson, Col. 1 Lines 42 – 44).

45. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. U.S. Patent No. (5,926,624) and Bersson U.S. Patent No. (6,081,897), as applied to claims 17, 18, 24 and 27, an in further view of Fuchigami et al U.S. Patent No. (5,960,398).

46. As per claim 23, Katz as modified fails to teach the recording unit decrements the number of remakes and records the decremented number as copyright remake content. However, Fuchigami teaches the recording unit decrements the number of remakes and

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records the decremented number as copyright remake content (Fuchigami, et al., Col 5 Line 54, allowable copies).

47. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Fuchigami's copyright embedding apparatus with Katz's Digital information delivery service because it offers the advantage of managing copyrights in a storage medium (Fuchigami, Col.1 Lines 5 – 11).

Conclusion

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Tolentino whose telephone number is (571) 272-2661. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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